

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

JURY TRIAL DEMANDED

1

laws of Canada.

3. Plaintiff is ignorant of the true names and capacities of Defendants sued herein as DOES 1 through 10, inclusive, and therefore, sues these Defendants by such fictitious names. Plaintiff will amend its Complaint to allege the true names and capacities of Defendants designated herein as a DOE when ascertained. Plaintiff is informed and believes, and on such basis alleges that, Defendants, and each of them, designated herein as a DOE, acted in concert with each and every other Defendants, intended to and did participate in and caused the events, acts, practices and courses of conduct alleged herein, and proximately caused damage and injury thereby to Plaintiff as alleged herein.

JURISDICTION AND VENUE

4. This action arises under the Lanham Trademark Act, 15 U.S.C. Sections 1114, 1117, and 1125(a) and (c). This Court has original subject matter jurisdiction pursuant to 28 U.S.C. Sections 1331 and 1338.

5. Venue is proper in the United States District Court for the Northern District of California District pursuant to 28 U.S.C. §§ 1391(b) and (c); and 28 U.S.C. Section 1400(a).

GENERAL FACTUAL ALLEGATIONS

6. Plaintiff brings the instant action for declaratory relief pursuant to 28 U.S.C. Section 2201(a) to obtain a judicial declaration of its rights and priority in use of its VAPORALL and VA VAPORALL trademarks.

7. Plaintiff is an acclaimed manufacturer, seller, and distributor of high-quality electronic cigarettes and related products, including but not limited to electronic smoking vaporizers, electronic cigarette kits and accessories, electric batteries, atomizers, cartridges, refills, battery chargers, liquids, boxes, cases, and other accessories (collectively, "Products") throughout the United States. Since its inception beginning in or around September 19, 2012, Plaintiff has sold its Products using its trademarks

VAPORALL and VA VAPORALL throughout the United States, including on its website and through distributors in California, Oregon, Nevada, Texas, Oklahoma, Georgia, Kentucky, South Carolina, Pennsylvania, New Jersey, and New York.

8. Plaintiff prides itself on providing the best Products in the market and engages in substantial market research to ensure that its customers receive top-quality Products. Plaintiff's Products are backed by a thirty (30) day refund policy and one (1) year limited warranty to ensure that customers are satisfied with their purchases.

9. Plaintiff's Products include a wide variety of e-liquid juices, which include a selection of distinct, interesting, and intense flavors. All flavors offered for sale by Plaintiff have been hand selected and are created in a sanitary lab equipped with carbon filters to trap all dust particles and NSF Certified stainless steel tables and racks to avoid unwanted bacteria. Plaintiff's liquids are pure and never diluted with food coloring or water.

10. To protect its valuable, unique, and high-quality Products, Plaintiff has sought U.S. trademark registration for its VAPORALL and VA VAPORALL marks. On or about May 27, 2014, Plaintiff applied for registration of its VAPORALL word mark, Serial No. 86,292,416, in International Class No. 34, with a first use in commerce date of September 10, 2012. On or about May 28, 2014, Plaintiff applied for registration of its stylized VA VAPORALL mark, Serial No. 86,294,146, in International Class No. 34, with a first use in commerce date of September 10, 2012.

11. On or about April 21, 2014, Defendant applied for registration its VAPORA word mark, Serial No. 86,257,410, in International Class No. 34 under a Section 1(b) Intent-to-Use and Section 44(d) Application Based on a Foreign Application filing basis. A true and correct copy of Defendant's application for registration in the United States is attached hereto as Exhibit 1 and incorporated herein by reference. Defendant's application for registration is currently pending with the United States Patent and

1 Trademark Office (“USPTO”). The filing date of Defendant’s foreign application was October 24, 2013.

2 12. Defendant’s foreign use of its VAPORA mark in Canada is ineffectual to create trademark
3 rights in the United States as priority of trademark rights in the United States depends solely upon priority
4 of use in the United States and not on priority of use anywhere in the world.

5 13. Defendant’s prior use of its VAPORA mark in Canada does not entitle Defendant to claim
6 exclusive trademark rights in the United States where Plaintiff has used its VAPORALL and VA
7 VAPORALL marks in the United States prior to Defendant’s entry into the domestic American market.

8 14. Defendant’s VAPORA mark is not a famous mark and is not well known by reputation in
9 the United States.
10

11 15. On information and belief, Defendant has actively engaged or intends to actively engage
12 in the manufacture, advertisement, sale, and distribution of products which infringe upon Plaintiff’s
13 VAPORALL and VA VAPORALL marks, in clear violation of Plaintiff’s intellectual property rights and
14 interests.
15

16 16. Plaintiff is entitled to priority in use of its VAPORALL and VA VAPORALL marks as its
17 first use in commerce date of September 10, 2012 precedes Defendant’s April 21, 2014 filing of its intent
18 to use its VAPORA mark with the USPTO and further precedes Defendant’s October 24, 2013 filing of
19 its foreign application.
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21 17. Defendant’s intended and ongoing use of its VAPORA mark is confusingly similar,
22 infringes upon, and dilutes Plaintiff’s rights in its VAPORALL and VA VAPORALL marks. There
23 exists a reasonable likelihood of confusion, mistake, or error in the marketplace for persons who are
24 seeking to purchase electronic cigarettes, related products, and accessories.
25

26 18. Many electronic cigarette businesses have entered the growing marketplace by offering
27 inferior and subpar products. Plaintiff anticipates and has a reasonable apprehension that it will suffer lost
28

1 sales, substantial consumer confusion, and damage to its business reputation and goodwill if Defendant is
2 permitted to use or register its VAPORA mark in the United States.

3 **FIRST CAUSE OF ACTION**
4 **Declaratory Relief**

5 19. Plaintiff repeats, re-alleges, and incorporates by reference paragraphs 1 through 18 above
6 as though fully set forth herein.

7 20. An actual, substantial, and continuing controversy between Plaintiff and Defendant
8 concerning their respective rights and duties regarding the use of their respective trademarks in the United
9 States.

10 21. Plaintiff's Products bearing its VAPORALL and VA VAPORALL marks were introduced
11 to the U.S. market at least as early as September 10, 2012. Plaintiff contends that it is entitled to priority
12 in use of its VAPORALL and VA VAPORALL marks as its first use in commerce date of September 10,
13 2012 precedes Defendant's April 21, 2014 filing of its intent to use its VAPORA mark. Plaintiff further
14 contends that Defendant's intended and ongoing use of its VAPORA mark is confusingly similar,
15 infringes upon, and dilutes Plaintiff's rights in its VAPORALL and VA VAPORALL marks, resulting in
16 a reasonable likelihood of confusion, mistake, or error in the marketplace for persons who are seeking to
17 Plaintiff's Products. Plaintiff anticipates and has a reasonable apprehension that Defendant's use of its
18 VAPORA mark in the United States will cause Plaintiff to suffer lost sales, substantial consumer
19 confusion, and damage to its business reputation and goodwill.

20 22. On information and belief, Defendant contends that its VAPORA mark is sufficiently
21 distinct and dissimilar such that it does not infringe upon Plaintiff's marks and is not likely to cause
22 confusion, mistake, or error in the marketplace for persons who are seeking to purchase electronic
23 cigarettes, related products, and accessories.

24 23. Accordingly, there exists a substantial controversy of sufficient immediacy and reality to
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1 warrant the issuance of a declaratory judgment. A declaration of rights is both necessary and appropriate
2 at this time in order for Plaintiff to ascertain its rights and duties to sell its genuine and authentic Products
3 free of any conduct by Defendant that infringes upon Plaintiff's intellectual property rights and interests
4 in its VAPORALL and VA VAPORALL marks.

5 WHEREFORE, Plaintiff, Vu Doan dba Vaporall, prays for relief and judgment as follows:

- 6
- 7 1. A judicial determination and declaration that Plaintiff's VAPORALL and VA
8 VAPORALL marks have priority over Defendant's VAPORA mark;
 - 9 2. A judicial determination and declaration that Defendant's VAPORA mark is
10 confusingly similar to Plaintiff's VAPORALL and VA VAPORALL marks and there
11 exists a reasonable likelihood of confusion, mistake, or error in the marketplace;
 - 12 3. A judicial determination and declaration that Defendant's VAPORA mark may not be
13 used or registered as a mark in the United States and that Defendant be prevented from any
14 existing or continued use of its VAPORA mark;
 - 15 4. For reasonable attorney's fees and costs of suit incurred herein; and
 - 16 5. For such other and further relief as the Court may deem just and proper.
- 17

18 DATED: July 2, 2014

INHOUSE COUNSEL

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20
21 By: /s/ Ali Kamarei
22 Ali Kamarei, Esq.
23 Attorney for Plaintiff
24 Vu Doan dba Vaporall
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26
27
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EXHIBIT 1

PTO Form 1478 (Rev. 9/2005)
OMB No. 0951-0008 (Exp. 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 86257410

Filing Date: 04/21/2014

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86257410
MARK INFORMATION	
*MARK	<u>VAPORA</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	VAPORA
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	VAPORA INC.
*STREET	3437 Avenue du Musee
*CITY	Montreal, Quebec
*COUNTRY	Canada
*ZIP/POSTAL CODE (Required for U.S. applicants only)	H3G2C8
LEGAL ENTITY INFORMATION	
TYPE	company
STATE/COUNTRY UNDER WHICH ORGANIZED	Canada
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	034
	Cigarettes for use as an alternative to traditional cigarettes; Electric cigarettes

*IDENTIFICATION	containing tobacco substitutes; electronic smoking devices, namely electronic cigarettes, electronic smoking vaporizers; electronic cigarette kits and accessories associated with electronic cigarettes, namely, electric batteries, atomizers, cartridges, refills, battery chargers, liquids for electronic cigarettes, boxes and cases
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(d)
FOREIGN APPLICATION NUMBER	1650274
FOREIGN APPLICATION COUNTRY	Canada
FOREIGN FILING DATE	10/24/2013
INTENT TO PERFECT 44(d)	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
INTERNATIONAL CLASS	035
*IDENTIFICATION	Retail stores offering for sale the above described goods; Operation of a website offering information about smoking cessation and smoking alternative products; sale of smoking cessation and smoking alternative products
FILING BASIS	SECTION 1(b)
FILING BASIS	SECTION 44(d)
FOREIGN APPLICATION NUMBER	1650274
FOREIGN APPLICATION COUNTRY	Canada
FOREIGN FILING DATE	10/24/2013
INTENT TO PERFECT 44(d)	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
ATTORNEY INFORMATION	
NAME	Thomas J. Moore
ATTORNEY DOCKET NUMBER	VAPO6003/TJM

FIRM NAME	BACON & THOMAS, PLLC
STREET	625 Slaters Lane, Fourth Floor
CITY	Alexandria
STATE	Virginia
COUNTRY	United States
ZIP/POSTAL CODE	22314-1176
PHONE	703-683-0500
FAX	703-683-1080
EMAIL ADDRESS	mail@baconthomas.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Eugene Mar, Richard E. Fichter, Felix J. D'Ambrosio, and John R. Schaefer
CORRESPONDENCE INFORMATION	
NAME	Thomas J. Moore
FIRM NAME	BACON & THOMAS, PLLC
STREET	625 Slaters Lane, Fourth Floor
CITY	Alexandria
STATE	Virginia
COUNTRY	United States
ZIP/POSTAL CODE	22314-1176
PHONE	703-683-0500
FAX	703-683-1080
EMAIL ADDRESS	mail@baconthomas.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	2
FEE PER CLASS	325
*TOTAL FEE DUE	650
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	

SIGNATURE	/Thomas J. Moore/
SIGNATORY'S NAME	Thomas J. Moore
SIGNATORY'S POSITION	Owner's Attorney, Va. Bar Member
DATE SIGNED	04/21/2014

PTO Form 1479 (Rev. 9/2006)
CME No. 0351-0002 (Exp. 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 86257410

Filing Date: 04/21/2014

To the Commissioner for Trademarks:

MARK: VAPORA (Standard Characters, see mark)

The literal element of the mark consists of VAPORA.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, VAPORA INC., a company organized under the laws of Canada, having an address of
3437 Avenue du Musee
Montreal, Quebec H3G2C8
Canada

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 034: Cigarettes for use as an alternative to traditional cigarettes; Electric cigarettes containing tobacco substitutes; electronic smoking devices, namely electronic cigarettes, electronic smoking vaporizers; electronic cigarette kits and accessories associated with electronic cigarettes, namely, electric batteries, atomizers, cartridges, refills, battery chargers, liquids for electronic cigarettes, boxes and cases

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services and asserts a claim of priority based on Canada application number 1650274, filed 10/24/2013. 15 U.S.C. Section 1126(d), as amended.

INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

International Class 035: Retail stores offering for sale the above described goods; Operation of a website offering information about smoking cessation and smoking alternative products; sale of smoking cessation and smoking alternative products

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services and asserts a claim of priority based on Canada application number 1650274, filed 10/24/2013. 15 U.S.C. Section 1126(d), as amended.

INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

The applicant's current Attorney Information:

Thomas J. Moore and Eugene Mar, Richard E. Fichter, Felix J. D'Ambrosio, and John R. Schaefer of
BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
United States

The attorney docket/reference number is VAPO6003/TJM.

The applicant's current Correspondence Information:

Thomas J. Moore
BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
703-683-0500(phone)
703-683-1080(fax)
mail@baconthomas.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Thomas J. Moore/ Date: 04/21/2014
Signatory's Name: Thomas J. Moore
Signatory's Position: Owner's Attorney, Va. Bar Member
RAM Sale Number: 86257410
RAM Accounting Date: 04/21/2014

Serial Number: 86257410
Internet Transmission Date: Mon Apr 21 11:28:49 EDT 2014
TEAS Stamp: USPTO/BAS-50.246.95.157-2014042111284913
3099-86257410-500799911a99ac8e0c5cf8e502
bb9aacff9062e0988cd5b140d7d51f14dcf2b6d0
-DA-6835-20140421112528420407

VAPORA